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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,983	08/07/2001	Luo Steven	P01018US1A	3562

7590 04/27/2006
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EXAMINER
LEE, RIP A

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,983

Applicant(s)

STEVEN ET AL.

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5 and 23-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5 and 23-36 is/are rejected.
- 7) ☒ Claim(s) 1, 5, 25 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action follows Applicant's response filed on November 1, 2004. Claim 1 was amended. Claims 2-4 and 6-22 were canceled, and new claims 23-36 were added. Claims 1, 5, and 23-36 are pending.

Specification

1. The disclosure is objected to because of the following informalities: The line number at which the amendment to the specification is to be entered is missing. Please furnish the exact location of entry of said amendment. Also, in line of the amendment to the specification, please replace "1,2-polyguardiene" with "1,2-polybutadiene." Appropriate corrections are required.

Claim Objections

2. Claim 1 is objected to because of the following informalities: The structure is not required since specific stabilizer compounds have been recited in the claim. Appropriate correction is required.

3. Claim 5 is objected to because of the following informalities: Please change the dependency of the claim. Appropriate correction is required.

4. Claims 25 and 33 are objected to because of the following informalities: The diction is poor. Replace "derive" with "are derived." Replacement of "by employing" with "in the presence of" is suggested. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 5, and 23-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The numerical range limitations have been changed in the amended claims. Claim 1 recites a lower limit of 1.4 parts by weight of antioxidant per 100 parts by weight of syndiotactic 1,2-polybutadiene. Claim 29 recites an upper limit of 0.5 mmole of transition metal per 100 parts weight of syndiotactic 1,2-polybutadiene and a lower limit of 1.4 parts by weight of antioxidant per 100 parts by weight of syndiotactic 1,2-polybutadiene. Since none of these limits is disclosed with specificity in the present application, one skilled in the art would not consider the claimed ranges as being inherently supported by the discussion in the original disclosure. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

Since claims 5, 23-28, and 30-36 depend from independent claims 1 or 29, they are subsumed under the rejection. Moreover, the limitation "at least about 2 parts by weight" in claims 23 and 32 lacks adequate support in the instant application. The limitation "to about 0.5 mmole of transition metal" of claim 27, lacks support in U.S. 6,117,956, the contents of which were incorporated by reference.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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April 26, 2006



DAVID W. WU

SENIOR PATENT EXAMINER
TECHNOLOGY CENTER 1700